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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,500	12/17/2001	Michael R. Nowak	P/73-7	4401

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EXAMINER

NAKARANI, DHIRAJLAL S

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 04/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/023,500	Applicant(s) NOWAK ET AL.	
	Examiner D. S. Nakarani	Art Unit 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 3-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 3-20 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 21, 2003.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 2, lines 4-5, the phrase "copolymer and/or terpolymer resin consisting of butane, hexane and or octane in feedstocks" constitute new matter because the specification as originally filed does not provide support for the copolymer and/or terpolymer consisting of butane, hexane and/or octane in feedstocks. The original specification provides support for the copolymer and/or terpolymer consisting of butane, hexane and/or octane with ethylene in feedstock.
4. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Dethlefs et al (U. S. Patent 4,935,298).

Dethlefs et al disclose a paper coated on one side (i. e. back side) with a mixture of 60 wt% low-density polyethylene and 40 wt% linear low density polyethylene wherein the linear low density polyethylene is a copolymer of ethylene (99 mol%) and octane (1 mol%) (Col. 6, lines 45-54). Thus Dethlefs et al's paper coated on one side prior to coating other side (i. e. front side) meets claimed paper having layer of a copolymer of ethylene with octane and low-density polyethylene. The invention as claimed is an open language and inclusive of other layers, such as front layer, and/or other polymer and/or pigment such as low density polyethylene, titanium dioxide etc. The invention as claimed is a closed language only for the composition of copolymer and/or terpolymer made of recited monomers only.

5. Claims 1 and 2 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kittrell et al (U. S. Patent 5,196,269) with, as evidence, Eichbauer (U. S. Patent 5,922,441) and Ramesh et al (U. S. Patent 6,586,026 B1) for the reasons of record set forth in paragraph 7 of the Office Action mailed August 2, 2005 (Paper Number 20050625). Furthermore, the invention as claimed is inclusive of additional layer(s), such as skin layer (10), which does not affect novel feature of the claimed invention. The invention as claimed is a closed language only for the composition of copolymer and/or terpolymer made of recited monomers only.

Art Unit: 1773

6. Applicant's arguments filed February 02, 2006 have been fully considered but they are not persuasive. In reference to rejection of claims 1 and 2 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kittrell et al (U. S. Patent 5,196,269) with, as evidence, Eichbauer (U. S. Patent 5,922,441) and Ramesh et al (U. S. Patent 6,586,026 B1) that as stated by the Examiner, Kittrell contains other resins which are outside of this group in their coatings, and therefore, does not read on the claims of the current invention.


These arguments are not persuasive because the invention as claimed is only closed language for the composition of copolymer and/or terpolymer made of recited monomers only. However the layer of copolymer and/or terpolymer is inclusive of other components not recited in the claim. The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention (see MPEP 2111.03). There is nothing on record showing that Kittrell et al's skin layer (10) affects the basic and novel characteristic(s) of the claimed invention.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. S. Nakarani whose telephone number is (571) 272-1512. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1773

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


D. S. Nakarani
Primary Examiner
Art Unit 1773

DSN
April 5, 2006.